

Applicants : James C. Rush et al  
Serial No. : 09/800,006  
Confirmation : 5256  
Atty. Dkt. : STE01 P-1086  
Page : 31

**Remarks/Arguments:**

Reconsideration of the application as amended is requested.

The Examiner's additional remarks have been received and carefully considered.

Applicants note that the Examiner has withdrawn the previously indicated allowability of claims 76, 77 and 95-98 in view of a more careful review of the previously cited Dwillies Patent 5,277,512, and that the latest Office action is non-final. Pending claims 95-99 have been canceled without prejudice, and claims 100, 123, 134 and 140 have been amended.

Applicants note with appreciation the Examiner's comment that claims 30-34, 79, 82-87, 89 and 94 are allowed, and that claim 99 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims.

The Examiner objected to the amendment made in Applicants' response dated September 26, 2005 on the grounds that it "introduces new matter into the disclosure" as proscribed by 35 U.S.C. § 132(a). More specifically, the Examiner states,

"The added material which is not supported by the original disclosure is as follows: a T-nut and a cruciform. A cruciform is defined as a cross or arranged as a cross. The original specification merely discloses an 'X' or 'Y' configuration. Clearly a 'cruciform' is not an 'X' or a 'Y' configuration. As such the amendments to the specification have not been entered at this time. Applicant [sic] is required to cancel the new matter in the reply to this Office Action."

Applicants : James C. Rush et al  
Serial No. : 09/800,006  
Confirmation : 5256  
Atty. Dkt. : STE01 P-1086  
Page : 32

For those reasons set forth in detail below, Applicants assert that those amendments incorporated into the September 29, 2005 response do not include any “new matter” as contemplated by 35 U.S.C. § 132(a).

As set forth in § 608.04 of the MPEP, the “disclosure” of the application against which “new matter” is judged, includes the specification, drawings, and claims as originally filed.

As set forth in paragraph 5.4(a) of Harman’s Treatise Patents in the Federal Circuit,

“The fundamental inquiry is whether the material added by amendment was inherently contained in the original application. The new matter prohibition is closely related to the requirement, said to be found in the first paragraph of §112, that the specification support the claims. In 1967, the CCPA inaugurated use of §112 to prevent the addition of new matter to claims. As the CCPA noted, the function of the description requirement is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed. Although the statute proscribes addition of new matter to a specification or claims under §132, the CCPA decided to police the addition of new matter to the claims separately using §112, reasoning that the use of §132 or §112 was synonymous because a rejection of an amended claim under §132 is equivalent to a rejection under §112¶1. Since then, the Federal Circuit has continued to use §112 to ensure that a patentee had possession at the time of filing of subject matter subsequently claimed.” (Citations omitted.)

Applicants : James C. Rush et al  
Serial No. : 09/800,006  
Confirmation : 5256  
Atty. Dkt. : STE01 P-1086  
Page : 33

Turning first to the Examiner's characterization of "T-nut" as new matter, Applicants point out that the phrase "T-nut" was not included in any of the amendments set forth in Applicants' September 29, 2005 reply, and is therefore not newly added to the application in any sense. The original specification at page 13, lines 5-16 read as follows.

"A pair of T-fasteners 74 (Fig. 24A) are then assembled on post-to-beam connector 6 to securely mount the beam 2 on post 3 as described below. Each of the T-fasteners 74 (Fig. 24A) has a screw 75 with a threaded shank portion that is received in an associated one of the horizontal fastener apertures 66 and 67 in upper and lower key portions 64 and 65 of post-to-beam connector 6. Each of the T-fasteners 74 also includes a T-nut 76 which is shaped to be closely received in the post slot 5, and includes a central threaded aperture 77 in which the free end of the fastener screw 75 is threadedly received. The illustrated T-nut 76 has a substantially square plan configuration, with beveled outer edges 78 that facilitate insertion into post slot 5. The illustrated screws 75 are in the form of allen head bolts, and include a cylindric head 79 with a tool receiving recess 80 in the outer end thereof. The tightening of bolts 75 draws the end of the beam 2 and the associated post 3 together to securely, yet detachably, interconnect the same." (Emphasis added.)

The "T-nut" is clearly illustrated and designated by reference numeral 76 in the drawings beginning at Figs. 24-35. Hence, it is clear that the Examiner's characterization of a "T-nut"

Applicants : James C. Rush et al  
Serial No. : 09/800,006  
Confirmation : 5256  
Atty. Dkt. : STE01 P-1086  
Page : 34

as “new matter” under 35 U.S.C. § 132(a) is not well taken, since the phrase was not added in Applicants’ response of September 23, 2005, and in fact appeared throughout Applicants’ specification and drawings, as originally filed.

With respect to the term “cruciform”, Applicants’ response of September 29, 2005 did add this term to the specification at page 8, line 14, and also included the same in claims 100-122 and 134-139. While Applicants admit that the term “cruciform” did not appear in the application as originally filed, it is asserted that the inclusion of the same in both the specification and claims of Applicants’ September 29, 2005 amendment does not constitute “new matter” under 35 U.S.C. § 132(a), because the term “cruciform” is synonymous with the term “X-shaped”, and is otherwise fully supported by the specification, drawings and claims filed in Applicants’ original application.

According to Roget’s International Thesaurus (Fourth Edition), the terms “cruciform” and “X” have the following meanings.

“**cross**, **crux**, **cruciform**, **staur(o)-**; **crucifix**, **rood**; **crisscross**, **christcross**; **X**, **ex**, **exing**, **chi**, St. Andrew’s cross, *crux decussata* [L], saltire [her]; **T**, tau *crux commisa* [L], St. Anthony’s cross; **Y**, thieves’ cross, fork cross; **ankh**, key of the Nile, *crux ansata* [L]; **avellan cross**; cross botonée, trefled cross or cross of St. Lazarus; Calvary cross; Celtic or Iona cross; chi-rho, Christogram; crosslet, cross-crosslet; cross fitché; cross fleury, cross of Cleves; cross formée; cross fourchée; Greek cross, St. George’s cross; cross

Applicants : James C. Rush et al  
Serial No. : 09/800,006  
Confirmation : 5256  
Atty. Dkt. : STE01 P-1086  
Page : 35

grignolée; inverted cross, St. Peter's cross; Jerusalem cross, potent cross; **Latin cross**, long cross, *cruz capitata* [L], *crux immissa* [L], *crus ordinaria* [L], God's mark; cross of Lorraine; **Maltese cross**; cross moline, cross ancré, cross recercelée; papal cross; patriarchal or archiepiscopal cross; cross patée; cross pommée, cross bourdonnée; Russian cross; quadrate cross; **swastika**, gammadion, *Hakenkreuz* [Ger], *crux gammata* [L]; voided cross; pectoral cross; crossbones; dagger 586.20."

As noted above, Applicants assert that the terms "X-shaped" and "cruciform" are synonymous, and simply describe in words the shape clearly illustrated in Figs. 3, 15, 16, 26, 32 and 35 of the drawings as originally filed. That portion of the specification amended by Applicants' response of September 29, 2005 is set forth verbatim below.

--As shown in Figs. 3-6, in the illustrated furniture system 1, posts 3 include an X-shaped post 3a and a Y-shaped post 3b, which are substantially identical in construction. X-shaped post 3a has a cruciform plan shape defined in part by a central portion, and four, substantially identical, mutually perpendicular outwardly extending flanges 4a extending outwardly from the central portion, each of which has a flat end face 10a with a single vertical slot 5a extending centrally therealong. As best illustrated in Fig. 7, each of the slots 5 has a generally T-shaped lateral cross-sectional configuration with an enlarged interior track portion 11 and a reduced neck portion 12 which opens outwardly. The illustrated posts 3 have a hollow interior 13 with inwardly

Applicants : James C. Rush et al  
Serial No. : 09/800,006  
Confirmation : 5256  
Atty. Dkt. : STE01 P-1086  
Page : 36

projecting reinforcing ribs 14, and an end web 54 in each flange 4 that defines the base of slot 5.--"

As is apparent from the original and amended specification set forth above, the phrase "X-shaped" as appears in the original specification, and the term "cruciform" added thereto, are indeed synonymous, and refer to the shape shown in Figs. 3, 15, 16, 26, 32 and 35 which has a square central portion and four substantially identical mutually perpendicular flanges 4a extending outwardly from the central portion, each of which has a flat end face 10a with a single vertical slot 5a extending centrally therealong. Since the geometric shape which the terms "X-shaped" and "cruciform" describe is clearly set forth in the original application, and not changed by Applicants' September 29, 2005 amendment, Applicants assert that no "new matter" has been added to the application, as proscribed by 35 U.S.C. § 132(a). Simply using another word to describe the exact same shape disclosed in the original application cannot be considered "new matter". Hence, the Examiner's objection is not well taken, and should be withdrawn.

Furthermore, as noted above, pending claims 100-122 and 134-139 all contain the term "cruciform", but were not objected to by the Examiner, or rejected in the Office action of February 6, 2006. As set forth in § 608.04 of the MPEP,

Applicants : James C. Rush et al  
Serial No. : 09/800,006  
Confirmation : 5256  
Atty. Dkt. : STE01 P-1086  
Page : 37

"The subject matter which is considered to be new matter must be clearly identified by the examiner. If the new matter has been entered into the claims or affects the scope of the claims, the claims affected should be rejected under 35 U.S.C. 112, first paragraph, because the new matter is not described in the application as originally filed."

Hence, the Examiner's actions are inconsistent, and not in accordance with the rules of practice set forth in the MPEP. For those reasons set forth in detail below, Applicants assert that the addition of the term "cruciform" to the specification and claims of the pending application does not constitute "new matter" under 35 U.S.C. §132(a), such that the associated objection should be withdrawn.

The Examiner rejected pending claims 78, 98 and 100-142 under 35 U.S.C. § 112 (second paragraph), as being indefinite. More specifically, the Examiner states, "Claims 78, 98, 100, 102, 118, 120, 123, 125, 134, 136, 140 and 142 include broad terms such as 'substantially' and 'generally'. It is not clear if something less than, equal to, or greater than is defined by the claimed language. Correction is required."

Applicants assert that the terms "substantially" and "generally" are commonly used in patent claims, and do not render the same indefinite under 35 U.S.C. § 112 (second paragraph). Section 2173.05(b) of the MPEP specifically addresses the propriety of using relative terminology in patent claims, including the term "substantially", and other similar terms. Applicants assert that the use of the terms "substantially" and "generally" in the rejected

Applicants : James C. Rush et al  
Serial No. : 09/800,006  
Confirmation : 5256  
Atty. Dkt. : STE01 P-1086  
Page : 38

claims does not render the same indefinite under 35 U.S.C. § 112 since one of ordinary skill in the art would understand what is claimed, particularly in light of Applicants' specification. Applicants therefore request that the subject rejection be withdrawn.

The Examiner objected to pending claims 100, 123, 134 and 140 on the grounds that they include the phrase "and the like", and therefore render the same "indefinite". While Applicants believe that the subject claims are indeed definite as required under the Patent Statute, claims 100, 123, 134 and 140 have been amended to delete the phrase "and the like", such that the issue is now moot.

The Examiner rejected pending claims 76, 78 and 95-98 under 35 U.S.C. § 102(b) as being anticipated by the Dwillies Patent 5,277,512. More specifically, the Examiner takes the position that,

"DWILLIES discloses the use of a post and beam furniture system for partitioning open [sic] including a plurality of overhead beams (10), each having opposite ends; a plurality of vertical posts (12), each having a lower portion thereof adapted to be abuttingly supported in a freestanding fashion on a floor surface of the open office space in a laterally spaced apart relationship, and an upper portion thereof operably connected with the opposite ends of said overhead beams (10) to support said beams (10) at a predetermined elevation above average user height; at least one of said posts having an X-shaped plan (see figure 14E) configuration defining four mutually

Applicants : James C. Rush et al  
Serial No. : 09/800,006  
Confirmation : 5256  
Atty. Dkt. : STE01 P-1086  
Page : 39

perpendicular, outwardly extending flanges (F), each of which has an end face (EF) with a single T-shaped vertical slot (T) extending centrally therealong; at least one of said posts (12) having a Y-shaped plan configuration (see figure 14D) defining three regularly spaced apart, outwardly extending flanges (F2), each of which has an end face (EF2) with a single T-shaped vertical slot (T2) extending centrally therealong (Column 8, lines 57-65); and a plurality of beam-to-post connectors (14, 50) attached to the opposite ends of said beams, and detachably retained in said slot (T, T2) of aligned pairs of said flanges (F, F2) on said posts (12) to support said beams (10) on said posts (12) at said predetermined elevation. DWILLIES further includes at least one partition accessory (91) having a mount (92) that is detachably retained in the slots (T, T2). Regarding claim 78, as seen in figures 13 and 14A-E, the beams (10) includes [sic] opposite end faces (EF, EF2) having the T-slots (T, T2); wherein, each of the slots (T, T2) are generally similar in shape and size to receive the accessory (91) therein."

For those reasons set forth in detail below, Applicants assert that the post and beam furniture system set forth in rejected claim 76 is not anticipated by the Dwillies Patent 5, 277,512.

Claim 76 recites a post and beam furniture system for partitioning open office space, comprising a plurality of overhead beams, each having opposite ends, and a plurality of vertical posts, each having a lower portion thereof adapted to be abuttingly supported in a freestanding fashion on a floor surface of the open office space in a laterally spaced apart

Applicants : James C. Rush et al  
Serial No. : 09/800,006  
Confirmation : 5256  
Atty. Dkt. : STE01 P-1086  
Page : 40

relationship, and an upper portion thereof, operably connected with the opposite ends of the overhead beams to support the beams at a predetermined elevation above average user height.

Rejected claim 76 further recites that at least one of the posts has an X-shaped plan configuration defining four mutually perpendicular, outwardly extending flanges, each of which has an end face with a single T-shaped vertical slot extending centrally therealong.

Rejected claim 76 further recites that at least one of the posts has a Y-shaped plan configuration defining three regularly spaced apart, outwardly extending flanges, each of which has an end face with a single T-shaped vertical slot extending centrally therealong.

Rejected claim 76 further recites a plurality of beam-to-post connectors attached to the opposite ends of the beams, and detachably retained in the slot of an aligned pair of the flanges on the posts to support the beams on the posts at a predetermined elevation. Finally, rejected claim 76 recites at least one partition accessory configured to equip the furniture system for users, and have a mount portion thereof detachably retained in the slot of one of the posts.

The Dwillies Patent 5,277,512 discloses a joint for detachable connection of structural members for applications such as temporary display systems, modular kitchen cabinets, shelving units and the like. The illustrated temporary displays are stated to be used for advertising, displaying information at conferences and the like, and are ideally light in weight, inexpensive and easy to assemble into a wide variety of different configurations. Fig. 1 of Dwillies '512 shows a temporary display stand comprising a framework of horizontal members

Applicants : James C. Rush et al  
Serial No. : 09/800,006  
Confirmation : 5256  
Atty. Dkt. : STE01 P-1086  
Page : 41

10 and vertical members 12. Panels 20 are fitted into some of the rectangular openings in the framework. Panels 20 are slightly wider than the distance between vertical members 12, so that the edges of panels 20 fit inside slots in vertical members 12. Panels 20 are thereby held within the framework. The Dwillies '512 specification also indicates that horizontal members 10 may also have longitudinal slots 22 to receive the upper and lower edges of panels 20, so that panels 20 are firmly retained in and stabilize the framework. The horizontal members 10 have resilient T-shaped tongues that mate with T-shaped slots on the vertical members 12. Rotation of the tongue within the slot causes a wedging action which stretches the tongue to draw the tongue firmly into the slot.

Fig. 2 of the Dwillies '512 patent shows the connection of one horizontal member 11 to an associated vertical member 13. Horizontal member 11 has projecting tongue 14 which is lockingly engaged with longitudinal slot 16 in the face 18 of vertical member 13. Horizontal member 11 is held in place at right angles to vertical member 13 by frictional engagement between the end 20 of horizontal member 11 and the face 18 of vertical member 13 and between tongue 14 and the inside surface of slot 16. More specifically, the tongue is engaged in the slot by rotating it about its axis, causing the end of the tongue to be drawn into the slot by wedging action between the tongue and the sloped inner surfaces of the slot.

While the Dwillies '512 patent does disclose a T-slot and a mating T-fastener joint for temporary displays and other similar applications, it does not contemplate the post and beam

Applicants : James C. Rush et al  
Serial No. : 09/800,006  
Confirmation : 5256  
Atty. Dkt. : STE01 P-1086  
Page : 42

furniture system for partitioning open office space set forth in rejected claim 76. More specifically, the Dwillies '512 patent does not disclose a "post and beam furniture system for partitioning open office space" as expressly set forth in rejected claim 76. Rather, the Dwillies patent discloses a joint for detachable connection of structural members for applications such as temporary display systems, modular kitchen cabinets, shelving units and the like.

Furthermore, the Dwillies patent does not disclose the use of "overhead beams" as expressly set forth in rejected claim 76. Also, the Dwillies patent does not teach at least one post having an "X-shaped plan configuration defining four mutually perpendicular, outwardly extending flanges, each of which has an end face with a single T-shaped vertical slot extending centrally therealong", as expressly set forth in rejected claim 76. The vertical members or posts 12 disclosed in the Dwillies '512 patent have a square shape with no outwardly extending flanges. Furthermore, the Dwillies '512 patent does not disclose at least one post having a "Y-shaped plan configuration defining three regularly spaced apart, outwardly extending flanges, each of which has an end face with a single T-shaped vertical slot extending centrally therealong", as expressly set forth in rejected claim 76. The post illustrated in Fig. 14B of the Dwillies '512 patent has a triangular shape, with no outwardly extending flanges having T-shaped vertical slots in the associated end face. Furthermore, the subject Dwillies patent does not disclose "at least one partition accessory configured to equip said furniture system for users, and having a mount portion thereof detachably retained in the one slot of the post". The shelf bracket 91

Applicants : James C. Rush et al  
Serial No. : 09/800,006  
Confirmation : 5256  
Atty. Dkt. : STE01 P-1086  
Page : 43

illustrated in Fig. 10 of Dwillies '512 is not "configured to equip said furniture system for users.

When examining a claim under 35 U.S.C. § 102, the Federal Circuit has held that prior art is anticipatory only if each and every element of the claimed invention is disclosed in a single item of prior art in the form literally defined in the claim. Jamesbury Corp. v. Litton Indus. Products, 225 USPQ 253 (Fed. Cir. 1985). In the case of Hybritech Inc. v. Monoclonal Antibodies, Inc., 231 USPQ 81 (Fed. Cir. 1986), the Federal Circuit stated, "It is axiomatic that for prior art to anticipate under § 102 it has to meet every element of the claimed invention."

Both the Patent and Trademark Office and the Federal Circuit require that for a claimed invention to be properly rejected under § 102(b), the claimed invention must be completely described or illustrated within the four corners of a single, prior art reference. 3 Patent Practice 11-71. Furthermore, the prior art reference must be enabling, thus placing the allegedly disclosed subject matter in the possession of the public. Akzo N.V. v. U.S. Int'l Trade Comm'n, 1 USPQ2d 1241 (Fed. Cir. 1986). No structural or functional difference between a claimed invention and the prior art may be ignored, unless the inventor himself says it is of not consequence.

Applicants : James C. Rush et al  
Serial No. : 09/800,006  
Confirmation : 5256  
Atty. Dkt. : STE01 P-1086  
Page : 44

Contrary to the Examiner's statement that all elements are disclosed in the subject Dwillies patent, each of those elements outlined specifically above is not. Hence, the rejection is unsupported by the art, and should be withdrawn.

Rejected claim 78, which depends directly from claim 76 further indicates that at least one of the beams includes opposite side faces, each of which has a T-shaped hanger slot extending longitudinally therealong, and that each of the slots in the posts and beams is generally similar in size and shape to receive the mount portion of the accessory therein.

In addition to those missing claim elements noted above with respect to claim 76, the Dwillies '512 beams 11 do not have opposite side faces with T-shaped hanger slots, nor are they adapted to receive the mount portion of an accessory therein. Contrary to the Examiner's statement, the configurations illustrated in Figs. 14A-14E of the Dwillies '512 patent are not beams, but rather posts. The Dwillies patent at column 8, line 60 expressly states,

"The various members shown in FIG. 14 may be used to construct frameworks with different symmetries. FIGS. 14(a), (b), and (c) are transverse cross sections through members having two slots for making structures with corners of 90°, 135 and 180° respectively. FIG. 14(d) is a transverse cross section through a member having three slots for joining three walls of a structure at 120 degree separation. FIG. 14(e) is a transverse cross section through a member having four slots for joining four walls of a structure at 90 degree separation."

Applicants : James C. Rush et al  
Serial No. : 09/800,006  
Confirmation : 5256  
Atty. Dkt. : STE01 P-1086  
Page : 45

Clearly, the Dwillies '512 patent teaches using the structures illustrated in Figs. 14A-14E only as posts, otherwise they could not achieve the angular configurations disclosed in the Dwillies '512 patent. Since the Dwillies '512 patent does not disclose those elements set forth in detail above, the rejection is unsupported by the art, and should be withdrawn.

With respect to the Examiner's rejection of claims 95-99 as anticipated by the Dwillies '512 patent, Applicants believe that the rejections are similarly not well taken. However, since claims 95-99 inclusive have been canceled without prejudice, the issue is moot.

Since new claims 100-145 were not rejected by the Examiner on the art of record, Applicants believe that the same are now in condition for immediate allowance, along with allowed claims 30-34, 79, 82-87, 89 and 94.

Applicants submit that all pending claims are sufficiently definite under 35 U.S.C. § 112, so as to reasonably apprise those skilled in the art as to their scope. Applicants further submit that the Dwillies '512 patent does not disclose the unique post and beam furniture system for partitioning open office space set forth in rejected claims 76 and 78. It is therefore

Applicants : James C. Rush et al  
Serial No. : 09/800,006  
Confirmation : 5256  
Atty. Dkt. : STE01 P-1086  
Page : 46



respectfully submitted that claims 76, 78 and 100-145 inclusive should be allowed, along with allowed claims 30-34, 79, 82-87, 89 and 94. A notice to this effect is earnestly solicited.

Respectfully submitted,

JAMES C. RUSH ET AL

By: Price, Heneveld, Cooper, DeWitt &  
Litton, LLP



Carl S. Clark  
Registration No. 28 288  
695 Kenmoor S.E.  
P.O. Box 2567  
Grand Rapids, Michigan 49501  
616/949-9610

CERTIFICATE OF MAILING

I hereby certify that this correspondence, and all identified enclosures and attachments are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450, on 5/2/06.



Carl S. Clark

CSC/jkrp  
Enclosures